



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,616	12/13/2001	Charles H. Lenore	DBH-0001	6587
23413	7590	11/22/2005	EXAMINER	
CANTOR COLBURN, LLP 55 GRIFFIN ROAD SOUTH BLOOMFIELD, CT 06002			MOONEYHAM, JANICE A	
			ART UNIT	PAPER NUMBER
			3629	
DATE MAILED: 11/22/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/020,616	LENORE ET AL.	
	Examiner	Art Unit	
	Janice A. Mooneyham	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 13 December 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-46 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-46 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

DETAILED ACTION

1. This is in response to the applicant's communication filed on December 13, 2001, wherein claims 1-46 are pending.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on March 26, 2002 is being considered by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2, 17, and 31 recite the limitation "the user". There is insufficient antecedent basis for this limitation in the claim. Claims 1, 16, and 13 refer to providing the legal information to a client, not a user.
4. Claims 2-8, 17-28, and 34-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear what the term client defines and what the term contributor defines.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 16, and 30-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Krachman (US 6,738,760).

Referring to Claims 1, 16, and 30-33:

Krachman discloses a method, system, and storage medium for managing legal information related to at least one legal matter in a system including a legal enterprise system and a remote system (Figure 3), the system comprising a storage system coupled via a network for communicating information (300), a database (34), the method comprising:

storing legal information in a database associated with the storage system, said legal information including an evidentiary outline corresponding to the legal matter (Figures 1 and 7-13), the evidentiary outline including a party's position and a link to evidence (Figure 1 (11) Deposition Transcripts etc.) stored in the database supporting the party's position (Figure 1 (11) Fact chronologies/Issues); and

providing the legal information to a user via the network (Figures 7-13).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-15, 17-28, and 34-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over claims Krachman as applied to claim 1, 16, and 33 above, and further in view of Embracing the Virtual Office Concept: How Legal Anywhere Collatorator! Can Help, By David H. Griggs published February 2000 (hereinafter referred to as Griggs).

Referring to Claims 2-3, 17-18, and 34-35:

Krachman does not disclose determining if the user is a client or a contributor based on the user identification and password.

Griggs discloses determining if the user is a client or a contributor based on the user identification and password (page 2 you can collaborate with individuals outside of the firm – be they clients or outside co-counsel. Again, you can authorize or restrict access to anyone you wish and likewise limit access to certain areas for those who can access the site -Collaborator permits you to grant editing rights to other parties participating in the case/transaction (clients, co-counsel, colleagues); page 3 Security. The service implements easy to use security features, including token sessions, expiring session Ids, address and authentication control).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the legal system of Krachman the security as taught in Griggs so as to ensure that client information and other internal

information within the system is secure while allowing one to collaborate with individuals outside of the firm.

Referring to Claims 4, 19, and 36:

Krachman discloses enabling a contributor to add a further link to further evidence in the database (col. 3, lines 54-56)

Referring to Claims 5, 20, and 37:

Griggs discloses enabling the contributor to edit the link to the evidence (page 2 Collaborator permits you to grant editing rights).

Referring to Claims 6, 21, and 38:

Griggs discloses restricting access to the legal information if the user is a client (page 2 you can collaborate with individuals outside of the firm – be they clients or outside co-counsel. Again, you can authorize or restrict access to anyone you wish and likewise limit access to certain areas for those who can access the site -Collaborator permits you to grant editing rights to other parties participating in the case/transaction (clients, co-counsel, colleagues)).

Referring to Claims 7-8, 22-23, and 39-40:

Griggs discloses wherein the contributor has access to legal information related to all of the plurality of legal matters and wherein the contributor has access related to a subset of all of the plurality of legal matters (page 2 you can collaborate with individuals outside of the firm – be they clients or outside co-counsel. Again, you can authorize or restrict access to anyone you wish and likewise limit access to certain areas for those who can access the site -

Collaborator permits you to grant editing rights to other parties participating in the case/transaction (clients, co-counsel, colleagues).

Referring to Claims 9, 24, and 41:

Griggs discloses wherein the legal information is encrypted prior to transmission to the storage system (page 3 solutions is as secure as the current encryption levels allow).

Referring 10-14, 25-29, and 42-46:

Krachman discloses wherein the evidence includes documents produced during discovery, response to interrogatories, deposition transcripts, audio files, and video files (Figures 7-9 and col. 4, lines 20-26).

Referring to Claim 15:

Krachman discloses wherein the evidentiary outline includes parties' position (Figure 1 (11) Facts/Issues).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Legal NetEx User Manual, discloses an Internet based collaborative and document management technology.

Extranets discloses an extranet is an intranet with exclusive hyperlinks to other locations used to share information in law firms.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jan Mooneyham
Patent Examiner
Art Unit 3629